

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, Colorado 80527-2400

## PATENT APPLICATION

ATTORNEY DOCKET NO. 10006908-1

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MAR 25 2005

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert C. Mayes

Confirmation No.: 4787

Application No.: 09/653,224

Examiner: Tan. D. Nguyen

Filing Date: Aug. 31, 2000

Group Art Unit: 3629

Title: Tailored Method and System For Custom Manufactured Books

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on Jan. 26, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Number of pages: 23

Typed Name: Tanra F. Paulin

Respectfully submitted,

Robert C. Mayes

By 

Jack H. McKinney

Attorney/Agent for Applicant(s)

Reg. No. 45,685

Date: Mar. 25, 2005

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SERIAL NO.: 09/653,224

EXAMINER: Tan D Nguyen

FILED: 8/31/2000

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MANUFACTURED BOOKS

APPELLANT'S/APPLICANT'S REPLY BRIEF ON APPEAL

1. ADDITIONAL GROUNDS FOR REJECTION TO BE REVIEWED.

The phrase "selecting format criteria and page and cover media" does not render Claims 1, 4-6, 7-11, and 12-15 indefinite under 35 U.S.C. 112, second paragraph.

2. ARGUMENT

The phrase "selecting format criteria and page and cover media" does not render Claims 1, 4-6, 7-11, and 12-15 indefinite under 35 U.S.C. 112, second paragraph. The Examiner rejected Claims 1, 4-6, 7-11, and 12-15 indefinite under 35 U.S.C. 112, second paragraph. Specifically the Examiner objected to the phrase "selecting format criteria and page and cover media" found in independent claims 1, 7, and 12. Claims 4-6, 8-11, and 13-15 contain the same phrase based on their dependency from Claims 1, 7, and 12 respectively.

According to MPEP 2173.02, the "essential inquiry" with respect to the second paragraph of §112 is whether "the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." Continuing, definiteness is not determined in a vacuum, "but in light of:

- (A) The content of the particular application disclosure;
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- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

A claim must be considered in its entirety when reviewing for compliance with §112. The totality of all claim limitations and their interaction with each other must be considered to determine whether the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2. See *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished but cited by MPEP 2173.02).

Claim 1 is directed to a book manufacturing method and includes the following combination of elements (the phrase objected to by the Examiner is emphasized):

1. identifying a set of books;
2. receiving a dimension of a book storage space;
3. **selecting format criteria and page and cover media** according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and
4. manufacturing the set of books according to the selected format criteria and using the selected page and cover media.

Reading the claim as a whole, one of ordinary skill in the art is apprised of the scope of the claim with respect to the phrase "selecting format criteria and page and cover media." The preamble indicates that the claim is directed to a book manufacturing method providing evidence that the format criteria and the page and cover media are related to a book being manufactured. Further, the format criteria defines at least a font size providing further evidence that the format criteria is related to text characteristics of a book being manufactured. Finally, a set of books is manufactured according to the selected format criteria using the selected page and cover media.

This indicated that the format criteria and the page and cover media at issue are for the books being manufactured.

When reviewing the claim as a whole, there is no ambiguity as to the meaning of the phrase "selecting format criteria and page and cover media." The same analysis applies to Claims 7 and 12. Consequently, the Examiners rejection of Claims 1, 4-6, 7-11, and 12-15 under the second paragraph of §112 is improper.

### 3. REPLY TO THE EXAMINER'S ANSWER.

In the opening brief, the Appellant/Applicant argued that Garrido (USPN 6,012,890) and Burton (USPN 4,598,376), alone or in combination, fail to teach or suggest receiving a dimension of a book storage space and selecting format criteria and page and cover media according to the received dimension so that a set of books, once manufactured, will fit within the book storage space in the manners required by Claims 1, 7 and 12..

Answering, the Examiner asserts the Garrido and Burton teach the following, and that their combination teaches the limitation at issue.

Garrido	Burton
<p>selecting the item's (book's) dimension parameters, a format criteria which includes at least a font size, and page and cover media {see c7:8-60, c9:1-10 which discloses "paper size, font size, and type"; c8:65-67 which discloses "cover can be printed"; c9: 1-1 0 which discloses "numbering of pages, type and size of fonts, design of printed matters, graphics to be included"</p> <p>(Examiner's Answer, page 4, para. 3)</p>	<p>selecting the item format criteria according to <i>[measurement of a customer's body]</i>, the selection being made so that the set of items, once manufactured, will fit within the item holder</p> <p>(Examiner's Answer, page 5, para. 3; <i>bracketed material added for clarity</i>)</p>

Garrido mentions altering format criteria in the nature of a font size. Garrido, col. 7, lines 8-13. Alteration of font size is are made manually in order to assist a visually challenged person. *Id*; see also col. 2, lines 20-25; col. 4, line 64 to col. 5, line 2; and col. 7, lines 23-28. Garrido further mentions that information including the font sizes to be used is passed from a distribution means (7) to a printing means (8).

Garrido, col. 9, lines 1-10. Garrido does not teach or suggest selecting a font size according to a received dimension so that a set of books, once manufactured will fit in a storage space in the manners required by Claims 1, 7, and 12.

Burton, directed to clothing manufacturing, mentions nothing of selecting format criteria in the nature of a font size for any reason. There is no reason, based on the teachings of Burton, that format criteria that includes a font size would ever be selected, let alone be selected so that a manufactured item will fit within a defined space. Contrary to the Examiner's assertion, noted in the table above, Burton does not teach the selection of format criteria so that a manufactured item will fit *within* anything. Clothing, such as suits as taught by Burton, fit *on* a customer and not *within* a customer.

The Examiner further contends :

As for the limitation of selecting the other book's dimension parameters, a format criteria and page and cover media, according to the received dimension, these are inherently included in the teachings of GARRIDO in view of BURTON et al as described above.

For, example, selecting a font size too high or big will increase the book thickness or height which may not fit the book holder. Selecting a cover so large would not fit into the holder properly.

Examiner's Answer, page 6, para. 2 to page 7, para. 1. There is nothing inherent in Burton and Garrido (individually or combined), concerning selecting format criteria (that includes a font size) according to a received dimension so that a set of manufactured books will fit within a book storage space having that dimension.

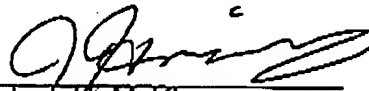
Garrido mentions that a user can manually select a font size to assist the visually impaired. Garrido does not even hint at selecting a font size so that a manufactured book containing text of that size will fit within a defined book storage space. Burton teaches the manufacturing of a suit in which the dimensions of a customer are received, fabric for the suit is cut to size according to those dimensions so that a manufactured suit will fit the customer.

With respect to the present application, font size is a characteristic of text imprinted on the pages of the books being manufactured to fit within the defined book storage space. The size of the font dictates the number of words that can appear on a page and thus the number of pages of a given size required to contain the text of a given book. The number of required pages then is a determining factor in the overall size of a set of books. Selection of an appropriate font size, then, will allow a set of

books fit within the defined book storage space. There is no parallel in Burton. For example, Burton mentions nothing of imprinting text on the fabric used to manufacture a suit for a customer let alone selecting a font size for that text so that the suit will fit the customer.

Simply stated, there is no reason one of ordinary skill in the art would look to Burton for guidance in selecting format criteria in the nature of font size so that a manufactured book would fit within a book storage space.

Respectfully submitted,  
Robert C. Mayes

By   
Jack B. McKinney  
Reg. No. 45,685  
(208) 433-1991

**APPENDIX OF CLAIMS INVOLVED IN THE APPEAL**

1. A book manufacturing method, comprising:  
identifying a set of books;  
receiving a dimension of a book storage space;  
selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and  
manufacturing the set of books according to the selected format criteria and using the selected page and cover media.
4. The method of claim 1, further comprising receiving payment information.
5. The method of claim 1, further comprising receiving payment information prior to manufacturing.
6. The method of claim 5, further comprising providing a purchase cost for manufacturing the set of books.
7. A book on demand system, comprising:  
an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;  
a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and  
a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

8. The book on demand system of claim 7, wherein the order placement system is capable of providing the user with a purchase cost.

9. The book on demand system of claim 8, wherein the order placement system is further capable of receiving payment information and the print module is operable to only print the cover and the pages after the order placement system receives payment information.

10. The book on demand system of claim 9, further comprising an electronic database for storing the book in an electronic form.

11. The book on demand system of claim 10, wherein the print module includes at least one printer, coupled to the order placement system, for printing the pages and cover of the book.

12. Computer readable media having instructions for:  
receiving input identifying a set of books;  
receiving input defining a dimension of a book storage space;  
selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and

directing the production of the set of books according to the selected format criteria and using selected page and cover media.

13. The media of claim 12, having further instructions for receiving payment information.

14. The media of claim 13, wherein the instructions for directing include instructions for directing only upon receipt of payment information.

15. The media of claim 14, having further instructions for providing a purchase price for the book.

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INVENTOR(S): Robert C. Mayes

GROUP ART UNIT: 3629

SERIAL NO.: 09/653,224

EXAMINER: Tan D Nguyen

FILED: 8/31/2000

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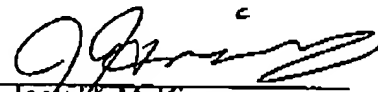
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  - receiving a dimension of a book storage space;
  - selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and
  - manufacturing the set of books according to the selected format criteria and using the selected page and cover media.
4. The method of claim 1, further comprising receiving payment information.
5. The method of claim 1, further comprising receiving payment information prior to manufacturing.
6. The method of claim 5, further comprising providing a purchase cost for manufacturing the set of books.
7. A book on demand system, comprising:
  - an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;
  - a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and
  - a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

8. The book on demand system of claim 7, wherein the order placement system is capable of providing the user with a purchase cost.

9. The book on demand system of claim 8, wherein the order placement system is further capable of receiving payment information and the print module is operable to only print the cover and the pages after the order placement system receives payment information.

10. The book on demand system of claim 9, further comprising an electronic database for storing the book in an electronic form.

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12. Computer readable media having instructions for:  
receiving input identifying a set of books;  
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selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and  
directing the production of the set of books according to the selected format criteria and using selected page and cover media.

13. The media of claim 12, having further instructions for receiving payment information.

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**3. REPLY TO THE EXAMINER'S ANSWER.**

In the opening brief, the Appellant/Applicant argued that Garrido (USPN 6,012,890) and Burton (USPN 4,598,376), alone or in combination, fail to teach or suggest receiving a dimension of a book storage space and selecting format criteria and page and cover media according to the received dimension so that a set of books, once manufactured, will fit within the book storage space in the manners required by Claims 1, 7 and 12..

Answering, the Examiner asserts the Garrido and Burton teach the following, and that their combination teaches the limitation at issue.

Garrido	Burton
selecting the item's (book's) dimension parameters, a format criteria which includes at least a font size, and page and cover media {see c7:8-60, c9:1 -10 which discloses "paper size, font size, and type"; c8:65-67 which discloses "cover can be printed"; c9: 1-1 0 which discloses "numbering of pages, type and size of fonts, design of printed matters, graphics to be included"	selecting the item format criteria according to [ <i>measurement of a customer's body</i> ], the selection being made so that the set of items, once manufactured, will fit within the item holder
(Examiner's Answer, page 4, para. 3)	(Examiner's Answer, page 5, para. 3; <i>bracketed material added for clarity</i> )

Garrido mentions altering format criteria in the nature of a font size. Garrido, col. 7, lines 8-13. Alteration of font size is are made manually in order to assist a visually challenged person. *Id*; see also col. 2, lines 20-25; col. 4, line 64 to col. 5, line 2; and col. 7, lines 23-28. Garrido further mentions that information including the font sizes to be used is passed from a distribution means (7) to a printing means (8).

Garrido, col. 9, lines 1-10. Garrido does not teach or suggest selecting a font size according to a received dimension so that a set of books, once manufactured will fit in a storage space in the manners required by Claims 1, 7, and 12.

Burton, directed to clothing manufacturing, mentions nothing of selecting format criteria in the nature of a font size for any reason. There is no reason, based on the teachings of Burton, that format criteria that includes a font size would ever be selected, let alone be selected so that a manufactured item will fit within a defined space. Contrary to the Examiner's assertion, noted in the table above, Burton does not teach the selection of format criteria so that a manufactured item will fit *within* anything. Clothing, such as suits as taught by Burton, fit *on* a customer and not *within* a customer.

The Examiner further contends :

As for the limitation of selecting the other book's dimension parameters, a format criteria and page and cover media, according to the received dimension, these are inherently included in the teachings of GARRIDO in view of BURTON et al as described above.

For, example, selecting a font size too high or big will increase the book thickness or height which may not fit the book holder. Selecting a cover so large would not fit into the holder properly.

Examiner's Answer, page 6, para. 2 to page 7, para. 1. There is nothing inherent in Burton and Garrido (individually or combined), concerning selecting format criteria (that includes a font size) according to a received dimension so that a set of manufactured books will fit within a book storage space having that dimension.

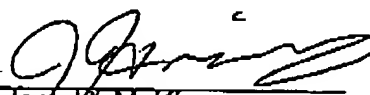
Garrido mentions that a user can manually select a font size to assist the visually impaired. Garrido does not even hint at selecting a font size so that a manufactured book containing text of that size will fit within a defined book storage space. Burton teaches the manufacturing of a suit in which the dimensions of a customer are received, fabric for the suit is cut to size according to those dimensions so that a manufactured suit will fit the customer.

With respect to the present application, font size is a characteristic of text imprinted on the pages of the books being manufactured to fit within the defined book storage space. The size of the font dictates the number of words that can appear on a page and thus the number of pages of a given size required to contain the text of a given book. The number of required pages then is a determining factor in the overall size of a set of books. Selection of an appropriate font size, then, will allow a set of

books fit within the defined book storage space. There is no parallel in Burton. For example, Burton mentions nothing of imprinting text on the fabric used to manufacture a suit for a customer let alone selecting a font size for that text so that the suit will fit the customer.

Simply stated, there is no reason one of ordinary skill in the art would look to Burton for guidance in selecting format criteria in the nature of font size so that a manufactured book would fit within a book storage space.

Respectfully submitted,  
Robert C. Mayes

By   
Jack B. McKinney  
Reg. No. 45,685  
(208) 433-1991

## APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A book manufacturing method, comprising:
  - identifying a set of books;
  - receiving a dimension of a book storage space;
  - selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and
  - manufacturing the set of books according to the selected format criteria and using the selected page and cover media.
4. The method of claim 1, further comprising receiving payment information.
5. The method of claim 1, further comprising receiving payment information prior to manufacturing.
6. The method of claim 5, further comprising providing a purchase cost for manufacturing the set of books.
7. A book on demand system, comprising:
  - an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;
  - a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and
  - a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

8. The book on demand system of claim 7, wherein the order placement system is capable of providing the user with a purchase cost.

9. The book on demand system of claim 8, wherein the order placement system is further capable of receiving payment information and the print module is operable to only print the cover and the pages after the order placement system receives payment information.

10. The book on demand system of claim 9, further comprising an electronic database for storing the book in an electronic form.

11. The book on demand system of claim 10, wherein the print module includes at least one printer, coupled to the order placement system, for printing the pages and cover of the book.

12. Computer readable media having instructions for:  
receiving input identifying a set of books;  
receiving input defining a dimension of a book storage space;  
selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and  
directing the production of the set of books according to the selected format criteria and using selected page and cover media.

13. The media of claim 12, having further instructions for receiving payment information.

14. The media of claim 13, wherein the instructions for directing include instructions for directing only upon receipt of payment information.

15. The media of claim 14, having further instructions for providing a purchase price for the book.